UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,673	07/28/2003	Hajime Sasaki	HIRA.0118	4610

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EXAMINER
QAYYUM, ZESHAN

ART UNIT	PAPER NUMBER
3685	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _08 May 2009_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-4_ is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-4_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All b)☐ Some * c)☐ None of:

     1.☐ Certified copies of the priority documents have been received.

     2.☐ Certified copies of the priority documents have been received in Application No. _____.

     3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
      Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
      Paper No(s)/Mail Date. _____

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 1-4 have been examined.

Response to Arguments

2. Applicant's arguments filed 05/08/2009 have been fully considered but they are
not persuasive. Applicant is of the opinion that prior art does not disclose: "a
managing server which stores a patient's medical information transmit to a
requester download permission key data for downloading the patient's medical
information in the managing server, the requester returns the download
permission key data to the managing server, and the managing server
authenticates validity of the download transmission key data transmitted from the
requester and transmits from the managing server to the requester a permission
response for transmitting the medical information of the patient to said
management server" While the claims are silent about who is performing the
receiving request, transmitting upload/download permission key data, and
authenticating validity of said upload/download permission, The Examiner for the
purposes of examination interpret as managing server is receiving the request...,
patient terminal transmitting the permission key data to the medical institution
terminal... and managing server authenticates validity of the upload/download
permission key data.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. <u>In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).</u>

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied.   This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claims fail prong (1) <u>because the "tie" (e.g. transmitting</u>
<u>said upload permission key data from said medical institution terminal to the</u>
<u>managing server) is representative of extra-solution activity</u>. Additionally, the
claim(s) fail prong (2) because the method steps do not transform the underlying
subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being
   indefinite for failing to particularly point out and distinctly claim the subject matter
   which applicant regards as the invention.

6. Claim 1 state "receiving a request from a patient terminal ….", "transmitting
   upload permission key data…" and "authenticating validity of said upload
   permission key data..." It is unclear to one of the ordinary skills who are
   performing receiving, transmitting and authenticating steps for example server,
   patient terminal or medical institution terminal.

7. Claim 2-4 state "receiving a medical information download request…",
   "transmitting download permission key data…", "receiving a permission response
   for ..." and "authenticating validity of said download permission key…" It is
   unclear to one of the ordinary skills who are performing receiving, transmitting,

receiving and authenticating steps for example server, patient terminal or medical

institution terminal.

8. The claims 1-4 are generally narrative and indefinite, failing to conform with

current U.S. practice. They appear to be a literal translation into English from a

foreign document and are replete with grammatical and idiomatic errors. Note the

format of the claims in the patent(s) cited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

9. **Claims1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Ballantyne (US 5867821) in view of Rozen (US 6073106).

10. With respect to claims 1-4, Ballantyne discloses Patient terminal, medical

institution terminal (i.e. clinics) (See column 6, lines 47-57 and Fig 1)

management server (i.e. Master library) (See column 4, lines 1-3, column 6, lines

32-35 and Fig 1 and 2) medical information storage device (See column 4, lines

4-15 and column 6, lines 20-31) management information control device (See

column 7, lines 16-22) Ballantyne also discloses receiving a request from a

patient terminal of a first patient among the plurality of patients to

upload/download in said management server (i.e. ML) medical information of

said first patient managed by a medical institution among said plurality of medical

institutions (See column 7 lines 66-67 and column 8, lines 1-5) Ballantyne does

not explicitly disclose: transmitting upload permission key data for uploading said

medical information of said first patient in said management server and a content

of said medical information of said first patient to be uploaded by the request to

said medical institution terminal of said medical institution from the managing

server; transmitting said upload permission key data from said medical institution

terminal to the managing server ; upon receiving said upload permission key data

transmitted from said medical institution terminal to the managing server,

authenticating validity of said upload permission key data with the managing

server, transmitting from the managing server to said medical institution terminal

a permission response for transmitting said medical information of said first

patient to said management server, and deferring upload of said medical

information of said first patient in the managing server; and upon receiving said

medical information of said first patient transmitted from said medical institution

terminal, storing said medical information of said first patient in said medical

information storage device.

Rozen discloses: transmitting upload permission key data for uploading said

medical information of said first patient in said management server and a content

of said medical information of said first patient to be uploaded by the request to

said medical institution terminal of said medical institution from the managing

server; transmitting said upload permission key data from said medical institution

terminal to the managing server ; upon receiving said upload permission key data

transmitted from said medical institution terminal to the managing server,

authenticating validity of said upload permission key data with the managing

server, transmitting from the managing server to said medical institution terminal

a permission response for transmitting said medical information of said first

patient to said management server, and deferring upload of said medical

information of said first patient in the managing server; and upon receiving said

medical information of said first patient transmitted from said medical institution

terminal, storing said medical information of said first patient in said medical

information storage device. (See column 5, lines 42-47, and column 7, lines 15-

67). Therefore, it would have been obvious to one of the ordinary skill in the art at

the time of invention was made to modify Ballantyne reference with Rozen in

order to provide data security.

In addition the claim stated the language "upon". However these are conditionals

languages and it has been held that conditional languages do not narrow the

claims because they can be omitted. According to MPEP "Language that

suggests or makes optional but does not require steps to be performed or does

not limit a claim to a particular structure does not limit the scope of a claim or

claim limitation" (MPEP §2106 II. C).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ZESHAN QAYYUM whose telephone number is (571)270-3323. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Z. Q./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685